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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/427,968	10/27/1999	DAVID P. COOK	26796-2	4007
27683	7590	12/19/2003	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			WORJLOH, JALATEE	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/427,968

Applicant(s)

COOK, DAVID P.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-9, 11-15 and 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-9, 11-15 and 19-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. In view of the Appeal Brief filed on November 17, 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Response to Arguments***

2. Applicant's arguments, see pages 4-6 (sections I & II), filed November 17, 2003, with respect to the rejection(s) of claim(s) 13 under 35 USC 101 and 35 USC 103 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a newly found prior art reference, EP385400 to Atalla et al.

Atalla discloses the step of confirming rights in the account by associating an account code provided by the customer with an account number associated with the account (see col. 4, lines 55-58 and col. 5, lines 1-16).

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3. Applicant's arguments with regards to independent claims 22 and 28, filed 11/17/03, have been fully considered but they are not persuasive.

Applicant argues that the examiner relies upon a single sentence in Talati to illustrate the proper combination of Talati in view of Linehan. Also, Applicant states that Talati teaches against using digital signatures (see col. 2, lines 10-14).

However, the examiner disagrees that Talati et al. in view of Linehan is an improper combination. Notice, the cited section, col. 5, lines 33-36, is not the only section that illustrates the use of digital signatures in Talati et al.; Col. 6, lines 31-32 and col. 8, lines 5-9 also supports digital signature technology. Therefore, although Talati et al. indicate in the *Background of the Invention* "There is also a need for secure electronic commerce where the exchange of digital signatures between entities is eliminated", the reference specifically disclose utilizing digital signatures in the *Detailed Description of the Invention*:

- Validation of the originator, recipient and transaction administrator may be validated by the use of digital signatures transmitted along with the various transmissions between parties in a known matter (see col. 5, lines 33-36)
- Additionally, digital signatures may be used to help identify parties (see col. 6, lines 31 and 32)
- When the client's bank receives an electronic check from the Check Clearing House it validates the check (authenticates the check with the client signature and available funds in the client's account (see col. 8, lines 5-9).

Therefore, Talati et al. do not teach against the use of digital signatures but actively utilizes it in their invention.

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4. Claims 6-9, 11-15, 19-36 have been examined.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 9, 11- 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5903878 to Talati et al. in view of European Patent No. 385400 to Atalla et al.

Referring to claim 13, Talati et al. disclose establishing a signature phrase for being used in a plurality of transactions, linking the signature phrase to the account number for use in the transactions; upon indication from a node associated with the e-commerce merchant that a transaction has initiated, providing an authorization form to a node associated with the customer, the authorization form being from a node associated with an entity separate from the e-commerce merchant, receiving the signature phrase from the node associated with the customer through a customer response to the authorization form, and extending rights to the account, normally only associated with the account code, to the signature phrase such that the customer can authorize the transaction made on the account using the signature phrase (see col. 10, lines 13-15, 41-67; col. 11, 1-20). Note. The CA is the credit authority (See col. 5, line 56). The CA generates an email including confirmation information. The confirmation message includes "randomly generated questions on which only the client has knowledge, such as birth date, mother's maiden name, social security number, etc."; the examiner interprets this confirmation e-mail message as an

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authorization form. As per receiving the signature phrase, after receiving the authorization form, the user of Talati et al.'s system generates an email message, providing therein a response to the random questions generated by the CA. The response to the random question is an authentication phrase. Additionally, although Talati et al. do not expressly disclose establishing a signature phrase for being used in a plurality of transactions this is an inherent step. That is, Talati et al. disclose receiving a signature phrase from a user and verifying the phrase, before receiving the phrase it must have been previously established. Also, the step of linking the signature phrase to the account number is an inherent step; that is, Talati disclose validating the identity of the originator (i.e. "account number") by requiring the originator to answer a series of question that only the originator knows (see col. 4, lines 56-57; col. 5, lines 36-37); the response to the question is the signature phrase. Thus, verifying the originator's identity with the signature phrase implies that the signature phrase and account number are associated/linked. Talati et al. do not expressly disclose confirming rights in the account by associating an account code provided by the customer with an account number associated with the account. Atalla et al. disclose confirming rights in the account by associating an account code provided by the customer with an account number associated with the account (see col. 4, lines 55-58; col. 5, lines 1-16). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the confirming rights in the account. One of ordinary skill in the art would have been motivated to do this because it secures the user's account.

Referring to claim 6, Talati et al. disclose the method wherein the authorization form includes a transformation system to transform the signature phrase by the node associated with

the customer, and wherein the interface receives the second account number and the second signature phrase in a transformed format (see col. 11, lines 11-16).

Referring to claim 9, Talati et al. disclose the method wherein the authorization form is provided to the node associated with the customer through a network interface (see col. 8, lines 26-29).

Referring to claim 11, Talati et al. disclose the method wherein the authorization form includes a customer-specific indicator previously provided by the customer to the entity, the customer-specific indicator being independent of the merchant (see col. 10, lines 64-67; col. 11, lines 1-2). Talati et al. disclose an authorization form including "...randomly generated questions on which only the client has knowledge..." this is therefore an authorization form with customer-specific indicator being independent of the merchant.

Referring to claim 12, Talati et al. disclose the authorization form includes information identifying the merchant (see col. 11, lines 61-66). Note. It is known in the art that purchase order data usually includes merchant information.

7. Claims 19-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. in further view of US Patent No. 6327578 to Linehan.

Referring to claim 22, Talati et al. disclose creating an authorization form at the authorization system, displaying the authorization form to the user, receiving an authentication phrase from the user, and verifying that the received authentication phrase corresponds to an authentication phrase in the account entry (see col. 10, lines 13-15, 41-67; col. 11, 1-20). Note. The CA is the credit authority (See col. 5, line 56). The CA generates an email including confirmation information. The confirmation message includes "randomly generated questions

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on which only the client has knowledge, such as birth date, mother's maiden name, social security number, etc."; the examiner interprets this confirmation e-mail message as an authorization form. As cited by Talati et al., the user can select "display mail" using a GUI to view the form. As per receiving an authentication phrase and verifying the phrase, after receiving the authorization form, the user of Talati et al.'s system generates an email message, providing therein a response to the random questions generated by the CA. Note. The response to the random question is an authentication phrase. Further, the CA confirms/verifies the answer to the question using the e-mail control system (ECS), which comprises a mailbox database storing e-mail storing "all information necessary to perform validation and authorization procedures at the CA (see col. 8, lines 45-47; col. 11, lines 27-37). Talati et al. do not expressly disclose receiving, at an authorization system, merchant information and account information after a user has initiated a transaction from a merchant using a network interface, verifying that the merchant information corresponds to the merchant, determining whether the account information corresponds to an account entry in an authorization database or transferring the user to the merchant. Linehan discloses receiving, at an authorization system, merchant information and account information after a user has initiated at transaction from a merchant using a network interface (see col. 4, lines 10-23), verifying that the merchant information corresponds to the merchant, and determining whether the account information corresponds to an account entry in an authorization database (see col. 4, lines 19-30; col. 7, lines 39-49; col. 10, lines 66-67) and transferring the user network interface of the user to the merchant (see col. 5, lines 54-57). Note. An interface is the point at which a connection is made between the elements so that they can work with each other or exchange information (Microsoft Press, pg. 241). Thus, Although



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Linehan does not specifically disclose "transferring the network interface of the user to the merchant" it can be infer. Linehan clearing illustrates and teaches a user and merchant communication and exchanging information via network. Hence, when the user communicates with the merchant, the user interface is being transferred to the merchant. Therefore, the step of "transferring the network interface of the user to the merchant" is an inherent and obvious step. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the steps of receiving, at an authorization system, merchant information and accounting information after a user has initiated at transaction from a merchant using a network interface, verifying that the merchant information corresponds to the merchant, determining whether the account information corresponds to an account entry in an authorization database, and transferring the network interface of the user to the merchant. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from using the user's account.

Referring to claim 19 and 20, Talati et al. disclose the authentication phrase is a signature phrase, and the signature phrase is transformed by the authorization form (see col. 11, lines 11-16).

Referring to claims 21 and 25, Talati et al. disclose the signature phrase is used for a plurality of different transactions with different merchants and the same authorizations system is for verifying different transactions for different merchants (see col. 2, lines 51-55).

Referring to claim 23, Talati et al. disclose a method for authorizing transactions (see claim 22 above). Talati et al. do not expressly disclose enabling the network interface of the user to be transferred to the authorization system. Linehan discloses enabling the network interface

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of the user to be transferred to the authorization system (see col. 15, lines 17-20). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step of enabling the network interface of the user to be transferred to the authorization system. One of ordinary skill in the art would have been motivated to do this because it provides means for verification. Note. See rationale regarding transferring network interface in claim 22 above.

Referring to claim 24, Talati et al. disclose forwarding an indication that the transaction is verified to the merchant (see col. 3, lines 49-54).

Referring to claim 26, Talati et al. disclose an authorization form (see col. 10, lines 41-67). Talati et al. do not expressly disclose the authorization form includes information associated with the authorization system. However, it is obvious to modify the authorization form disclose by Talati et al. to include information associated with the authorization system, doing so will not depart from the scope of Talati et al.'s system. Also, the information associated with the authorization system is non-functional descriptive information.

Referring to claim 27, Talati et al. disclose the authorization form includes information associated with the user but not provided by the user to the merchant (see col. 10, lines 64-67; col. 11, lines 1-2). Talati et al. disclose an authorization form including "...randomly generated questions on which only the client has knowledge..." this is therefore an authorization form with information associated with the user but not provided by the user to the merchant.

Referring to claim 28, Talati et al. disclose if signature authorization is to occur, preparing an authorization form at the central authorization facility, providing the authorization form to a node, receiving signature authorization form the node through the authorization form,

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authorizing the first transaction if the signature authorization corresponds to the first user information (see col. 10, lines 13-15, 41-67; col. 11, 1-20), and indicating the authorization to the first merchant (see col. 3, lines 49-54). Note. The CA is the credit authority (See col. 5, line 56). The CA generates an email including confirmation information. The confirmation message includes "randomly generated questions on which only the client has knowledge, such as birth date, mother's maiden name, social security number, etc."; the examiner interprets this confirmation e-mail message as an authorization form. As cited by Talati et al., the user can select "display mail" using a GUI to view the form. As per receiving signature authorization, after receiving the authorization form, the user of Talati et al.'s system generates an email message, providing therein a response to the random questions generated by the CA. The response to the random question is interpreted as signature authorization. Talati et al. do not expressly disclose receiving at a central authorization facility, a first merchant information and a first user information from a first merchant for a first transaction or verifying form at least one of the first merchant information and the first user information whether signature authorization is to occur. Linehan discloses receiving at a central authorization facility, a first merchant information and a first user information from a first merchant for a first transaction and verifying form at least one of the first merchant information and the first user information whether signature authorization is to occur (see col. 4, lines 19-30; col. 7, lines 39-49). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the steps of receiving at a central authorization facility, a first merchant information and a first user information from a first merchant for a first transaction and verifying form at least one of the first merchant information and the first user

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information whether signature authorization is to occur. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from using the user's account.

Referring to claims 29 and 30, Talati et al. disclose receiving at the central authorization facility (i.e. "transaction administrator"), merchant information (i.e. "recipient") and user information (i.e. "originator") (see col. 4, lines 50-57, 66-67; col. 5, lines 1-7). Also, Talati et al. disclose performing different transactions for "one or more" merchants and users, i.e. first merchant, second merchant, a second merchant information, first user information and second transaction (see col. 2, lines 51-55). Note. Talati et al. states, "The transaction administrator first validates the identity of recipient..." which implies that the recipient/merchant information has been received by the central authorization facility. As per repeating steps b)-g) for the second merchant wherein the same signature authorization is used to authorize the second transaction, see claim 28 above.

Referring to claim 31 and 32, Talati et al. disclose a method for authorizing e-commerce transactions (see claim 28 above). Talati et al. do not expressly disclose providing software to the merchant, wherein the software includes a Buy button. Linehan discloses providing software to the merchant (see col. 20, lines 22-28), wherein the software includes a Buy button (see col. 14, lines 23-27). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step of providing software to the merchant, wherein the software includes a Buy button. One of ordinary skill in the art would have been motivated to do this because it supports remote purchasing.

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Referring to claim 33, Talati et al. disclose the signature authorization is in the form of a signature phrase (see col. 11, lines 11-15).

Referring to claims 34 and 35, Talati et al. disclose the first user information includes a credit card account number (see col. 4, lines 50-56), and the central authorization facility is associated with an issuer of a credit card for the credit card account number (see col. 2, lines 67; col. 3, line 1).

Referring to claim 36, Talati et al. disclose the node indicated by the first account information is an electronic address for a user who initiated the transaction (see col. 10, lines 61-67).

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. and Atalla et al. as applied to claim 13 above, and further in view of U.S. Patent No. 5909492 to Payne et al.

Talati et al. disclose a method for authorizing transactions (see claim 13 above). Talati et al. do not expressly disclose creating a transaction certificate to memorialize a successful authorization, wherein the transaction certificate may be provided to the node associated with the e-commerce merchant to indicate successful authorization. Payne et al. disclose creating a transaction certificate to memorialize a successful authorization, wherein the transaction certificate may be provided to the node of the e-commerce merchant to indicate successful authorization (see col. 1, lines 37-48). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step of creating a transaction certificate to memorialize a successful authorization, wherein the transaction certificate may be provided to the node of the e-commerce merchant to

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indicate successful authorization. One of ordinary skill in the art would have been motivated to do this because it informs the consumer and the merchant that the transaction was valid (see Payne, col. 1, lines 37-48).

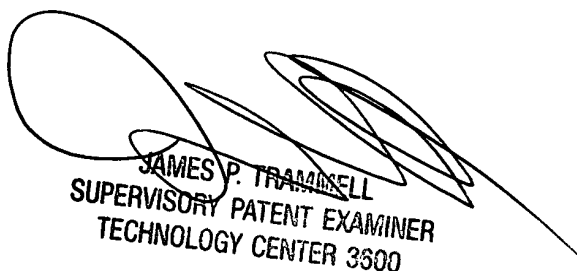
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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December 10, 2003

  
JAMES P. TRAMMELL  
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